



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Supplemental Appeal Brief Transmittal

In re application of: Bates, *et al.*

Serial No.: 09/633,766

Filed on: 08/07/00

For: **SATELLITE RADIO RECEIVER THAT DISPLAYS INFORMATION REGARDING ONE OR MORE CHANNELS THAT ARE NOT CURRENTLY BEING LISTENED TO**

Mail Stop APPEAL BRIEF - PATENT
Commissioner for Patents
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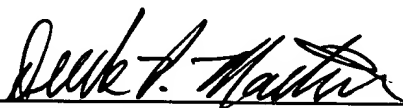
Sir:

In response to the pending office action dated 04/15/04, appellant respectfully requests reinstatement of the appeal. Transmitted herewith for filing is a **Supplemental Appeal Brief** in triplicate for the above-identified Application.

- ☒ Please deduct \$330.00 from Deposit Account No. 09-0465 for IBM Corporation to cover the fee under 37 C.F.R. §1.17(f) for the filing of the enclosed appeal brief. A duplicate copy of this sheet is enclosed.
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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bates, *et al.* Docket No.: ROC920000073US1
Serial No.: 09/633,766 Group Art Unit: 2683
Filed: 08/07/00 Examiner: D AGOSTA, STEPHEN M.

For: SATELLITE RADIO RECEIVER THAT DISPLAYS INFORMATION REGARDING
ONE OR MORE CHANNELS THAT ARE NOT CURRENTLY BEING LISTENED TO

SUPPLEMENTAL APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

JUL 21 2004
Technology Center 2600

Dear Sir/Madam:

This Supplemental Appeal Brief is filed in response to the appellant reinstating the appeal after the Examiner reopened prosecution in an office action dated 04/15/04.

REAL PARTY IN INTEREST

International Business Machines Corporation is the Real Party in Interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for this patent application.

STATUS OF CLAIMS

Claims 1-22 were originally filed in this patent application. In the first office action dated 1/16/03, all claims were rejected. In response to the first office action, a Request for Reconsideration was filed on 04/16/03. In the second office action dated 05/08/03, all claims were rejected. In response to the second office action, a Request for Reconsideration was filed on 08/08/03. In the third, final office action dated 09/17/03, all claims were rejected. In response, appellants filed a Notice of Appeal on 12/16/03, followed by an Appeal Brief on 02/17/04. In response to the Appeal Brief, the Examiner reopened prosecution, and sent a fourth office action dated 04/15/04, which is the pending office action. In this office action, claims 1, 6-9, 12 and 16-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,978,689 to Tuoriniemi *et al.* (hereinafter “Tuoriniemi”) in view of U.S. Patent No. 6,199,076 to Logan *et al.* (hereinafter “Logan”) and further in view of U.S. Patent No. 5,152,012 to Schwob. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi/Logan/Schwob in view of U.S. Patent No. 5,416,774 to Shigematsu *et al.* (hereinafter “Shigematsu”). Claims 3-4 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi/Logan/Shigematsu/Schwob in view of U.S. Patent No. 6,239,794 to Yuen *et al.* (hereinafter “Yuen”) and U.S. Patent No. 6,530,083 to Liebenow. Claims 5 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi/Logan/Shigematsu/Yuen/Schwob in view of U.S. Patent No. 6,177,931 to Alexander *et al.* (hereinafter “Alexander”). Claims 10-11 and 20-22 were allowed. Claims 1-22 as originally filed are currently pending.

STATUS OF AMENDMENTS

Appellant has not amended the claims. Because the Examiner has now allowed claims 10-11 and 20-22, the claims at issue in this appeal are claims 1-9 and 12-19 as originally filed.

SUMMARY OF INVENTION

A satellite radio receiver includes a display that displays information regarding one or more channels that are not currently being listened to. For a music channel, this information may include the name of the artist, the song title, time left in the song, etc. For a news channel, this information may include the news currently being discussed, the name of the news program, the time remaining, etc. For a sports channel, this information may include the name of the channel, a description of the sporting event, the time remaining, etc. The preferred embodiments include different ways to select which channels are “favorites” and therefore displayed on the display. One way is to select one or more channels that are assigned to preset buttons on the radio receiver. Another way is to keep track of which channels are most frequently listened to, and to display information regarding those channels. The preferred embodiments extend to any and all mechanisms for displaying information regarding one or more channels that are not currently being listened to.

ISSUES

The following issues are presented for review on this Appeal:

1. **Whether claims 1, 6-9, 12 and 16-19 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan and Schwob**
2. **Whether claim 2 is unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob and Shigematsu**
3. **Whether claims 3-4 and 13-14 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob, Shigematsu, Yuen, and Liebenow**
4. **Whether claims 5 and 15 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob, Shigematsu, Yuen, and Alexander**

GROUPING OF CLAIMS

Claims 1, 2, 6, 12 and 16 are grouped, and stand and fall together based on claim 1. Claims 3 and 13 are grouped, and stand and fall together based on claim 3. Claims 4 and 14 are grouped, and stand and fall together based on claim 4. Claims 5 and 15 are grouped, and stand and fall together based on claim 5. Claims 7 and 17 are grouped, and stand and fall together based on claim 7. Claims 8 and 18 are grouped, and stand and fall together based on claim 8. Claims 9 and 19 are grouped, and stand and fall together based on claim 9. This grouping of claims is appropriate because each set of claims includes a unique combination of limitations not found in the other sets of claims.

ARGUMENT

Issue 1: Whether claims 1, 6-9, 12 and 16-19 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan and Schwob

Claim 1

In the rejection of claims 1 and 12, the Examiner admits that Tuoriniemi and appellant's specification is silent on a display that displays information regarding at least one channel that is not selected wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel. The Examiner then cites to the audio program player in Logan, cites to the radio broadcast receiver in Schwob, and states that it would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to. Appellant respectfully asserts that the teachings of Logan do not read on the display of information regarding at least one satellite radio channel that is not the selected channel. Appellant further asserts that the Examiner's rationale for combining the cited references is defective.

Logan teaches an audio player. A user may interactively select program segments from a database to generate a desired program, then download the program from the database for listening on the audio player. While the program is playing, the user may jump to any program segment within the program, and play that selected program segment. Logan thus teaches the ability to jump between different program segments in a pre-recorded, downloaded audio program, thereby altering the presentation of the downloaded audio program to the user. The user interface of Logan allows a user to skip

a program segment, or to select a different program segment to play. This function is substantially the same as the function available on most compact disc players. The user may select the “next” button on a compact disc player to skip the current song (or the remainder of the current song). The user may also repeatedly press the “next” button to skip several songs until a desired song is reached, and then play the desired song.

Appellant respectfully asserts that the ability in Logan to play different portions of a pre-recorded, downloaded audio program does not read on the display of information regarding a satellite radio channel that is not the selected channel. Radio is a real-time broadcast medium. A user may tune to any desired station and listen to the program that is currently being broadcast. All channels that are available to a given radio receiver are simultaneously broadcasting their programs. To display information regarding at least one satellite radio channel that is not the selected channel requires monitoring the broadcast programs on one or more non-selected channels, in addition to playing the broadcast program that corresponds to the selected channel. Displaying information regarding program segments of a downloaded audio program is not even close to the same thing. One can easily display all of the program segments in Logan at the same time because these are pre-recorded segments that have been downloaded to the audio player. The teachings of Logan have no application to simultaneous, real-time satellite radio broadcasts. The program segments in Logan thus do not read on the satellite radio channels in claim 1, and displaying information regarding at least one satellite radio channel that is not the selected channel is not taught or suggested by the display of information regarding pre-recorded program segments in the pre-recorded audio program of Logan. For this reason, Logan does not read on these limitations in the claims.

The Examiner cites to Schwob because Schwob teaches a radio broadcast receiver that has a screen that is larger than normal and has the capacity/size to display many different pieces of information at the same time. The radio receiver in Schwob displays more information than many traditional radio receivers, including date, time, alarm, sleep mode, type of music, city, and state. Note, however, that the display in Schwob only

deals with the currently-selected station. Nowhere does Schwob teach or suggest that non-selected channels could be displayed.

The core issue is whether it would have been obvious to one of ordinary skill in art to provide a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel based on the teachings of the audio player for a pre-recorded, downloaded audio program in Logan. Appellant readily admits that Schwob teaches a display for a radio receiver that includes information not found in many prior art displays. However, the information on the Schwob display has nothing whatsoever to do with the display of information regarding one or more channels that are not the selected channel. Logan teaches an audio player that plays a downloaded audio program. A reasonable combination of Schwob and Logan might display program segments of a downloaded audio program of Logan on the display of Schwob. However, the program segments of the downloaded audio program of Logan do not read on the satellite radio channels in the claims.

Another problem with the Examiner's rejection is that it does not address the last clause of claim 1, which states: "wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel." The identifying information is referenced in lines 3 and 4 of claim 1, which states: "each digital satellite radio signal including a radio program and identifying information related to the radio program." The displayed information in claim 1 is thus derived from the identifying information that accompanies a radio program. The information displayed in Logan is the program segments that make up an audio program. The information displayed in claim 1 is information for at least one channel that is not the selected channel, wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel. Thus, in claim 1, each digital satellite radio signal includes a radio program and identifying information related to the radio program. The information displayed in lines 8-10 of claim 1 is information derived

from the identifying information for a non-selected satellite radio program. Appellant forcefully asserts that the display of information in a pre-recorded, downloaded audio program does not read on or otherwise render obvious the display of information for a non-selected satellite radio program. For this reason, the combination cited by the Examiner does not teach or suggest the display of information for a non-selected channel that is derived from the identifying information for the channel.

Appellant respectfully asserts that the Examiner's rationale for combining Tuoriniemi, Logan and Schwob is improper. The Examiner states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

If we strip away the specific language the Examiner uses, the Examiner's rationale basically states that it would be obvious to modify Tuoriniemi with features from the audio player in Logan and the display taught in Schwob to provide the advantages of the claimed invention. This is not a proper rationale for combining Tuoriniemi, Logan and Schwob. If an Examiner could establish obviousness by stating that a combination of references A, B and C would be obvious because of advantages only taught in the claims, the Examiner's job would be very simple, indeed. Nowhere does Tuoriniemi, Logan nor Schwob teach or suggest a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel. There is no motivation in any of these references to support their combination. The only motivation resides in appellant's claims, which amounts to impermissible hindsight reconstruction.

Appellant hereby challenges the Examiner to produce ANY motivation in the cited references or in general knowledge in the art for the proposed combination of Tuoriniemi, Logan and Schwob. To say that it would be obvious to combine the

references to produce the advantages of the claimed invention simply confirms that the claimed invention is useful and desirable. The fact that the advantages of the claimed invention are useful and desirable does not provide a reasonable rationale for combining the cited references.

One skilled in the art looking at these three references would realize that the display of program segments in Logan does not read on the display of information for non-selected satellite radio programs recited in the claims, and would therefore not be motivated to apply the teachings of Logan to Tuoriniemi and Schwob, as suggested by the Examiner. For these many reasons given above, appellant respectfully asserts that the Examiner's rejection of claim 1 is improper, and respectfully requests that the Examiner's rejection of claim 1 under 35 U.S.C. §103(a) be reversed.

Claims 6, 12 and 16

Claims 6, 12 and 16 are grouped with claim 1, and stand or fall according to the allowability of claim 1.

Claim 7

The arguments above with respect to claim 1 apply equally to claim 7, and are incorporated in this section by reference. In the rejection of claim 7, the Examiner reads the radiotext in Tuoriniemi on the limitations in claim 7. Note, however, that the radiotext in Tuoriniemi relates to the currently-selected channel, and Tuoriniemi does not explicitly teach the display of this radiotext. The "displayed information" in claim 7 relates to *at least one channel that is not the selected channel*, as expressly recited in claim 1. The existence of radiotext information for the currently-selected channel in Tuoriniemi does not teach or suggest the display of radiotext information for non-selected channels. For this reason, claim 7 is allowable over the cited art. In addition, claim 7

depends on claim 1, which is allowable for the reasons given above. As a result, claim 7 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 7 under 35 U.S.C. §103(a) be reversed.

Claim 17

Claim 17 is grouped with claim 7, and stands or falls according to the allowability of claim 7.

Claim 8

In the rejection of claims 8 and 18, the Examiner states: "Tuoriniemi teaches radiotext that identifies music, name of performer, change of program, etc., where the examiner interprets "etc." to include time remaining." How very convenient. Absent an express teaching in the cited art, the Examiner takes a simple expression "etc." and reads that expression to include a feature that is only taught in the claims. This amounts to a **CLEAR** case of hindsight reconstruction. How would one skilled in the art be motivated to display time remaining based on the word "etc." in Tuoriniemi? Such a position is ludicrous. Appellant forcefully asserts that the word "etc." cannot substitute for a positive recitation or suggestion of the limitation in the claim.

It is unbelievable that the Examiner, in reopening prosecution, did not clean up this messy part of the rejection of claim 8. Apparently the Examiner still believes that the word "etc." amounts to a positive teaching regarding time remaining. This position is just plain silly. Appellant respectfully requests that the Board send a strong message to the Examiner that such liberal reading of the prior art is improper.

The Examiner cites to the television display in Alexander which shows how long a program lasts. Oh boy, here we go again. The reason the Examiner reopened

prosecution in the first place is because he decided there was merit in the arguments in the Appeal Brief regarding the inappropriateness of liberally mixing and matching the teachings of radio and TV. That's why the Examiner substituted Logan in the pending office action for Dias, to get away from the rejection that mixes channel guides for televisions with a radio display. Yet here we are again, with the Examiner mixing the teachings of an on-line television channel guide with the teachings of satellite radio. Appellant strenuously asserts, for the many, many reasons given in the original Appeal Brief, that one of ordinary skill in the art would not be motivated to display time remaining for a song on a radio display based on time indications in an on-line television channel guide in Alexander.

The Examiner cites Logan as teaching the display of time remaining in the currently playing segment. The Examiner then states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the displayed information includes time remaining, to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or to change the channel.

Again, the Examiner attempts to justify the combination of the two references based on advantages taught solely in the claims. Logan teaches the display of time remaining for a program. Note, however, that the "displayed information" in claim 8 refers to the "displayed information regarding at least one channel that is not the selected channel" in claim 1. Logan cannot display "time remaining" for a non-selected program segment, because only one program segment in Logan is played at a time. Logan thus expressly teaches away from displaying time remaining for non-playing program segments. The Examiner essentially states that it would be obvious based on Logan to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or to change the channel. However, the time remaining in claim 8 is time remaining for the displayed information, which corresponds to at least one non-selected

channel in the claim. Thus, the Examiner's rationale for rejecting claim 8 is defective. *Nowhere has the Examiner asserted that it would be obvious based on Logan to display time remaining for non-selected channels.* The Examiner's rationale is based on allowing the user to decide based on time remaining for the selected station whether to keep listening to the station/song or to change the channel. This rationale does not address the limitation of displaying time remaining for radio programs on the non-selected channels. There is no teaching or suggestion in ANY of the cited references to support the display of time remaining for radio programs on non-selected channels. The only teaching of displaying time remaining for radio programs on non-selected channels is in the claims themselves. Hindsight reconstruction, pure and simple.

Appellant forcefully asserts that the combination of Tuoriniemi, Logan, Schwob, and Alexander does not render obvious claim 8, and that claim 8 is therefore allowable over the cited art. In addition, claim 8 depends on claim 1, which is allowable for the reasons given above. As a result, claim 8 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 8 under 35 U.S.C. §103(a) be reversed.

Claim 18

Claim 18 is grouped with claim 8, and stands or falls according to the allowability of claim 8.

Claim 9

The arguments above with respect to claim 1 apply equally to claim 9, and are incorporated in this section by reference. In the rejection, the Examiner reads the radiotext in Tuoriniemi on the limitations in claim 9. Note, however, that the radiotext in Tuoriniemi relates to the currently-selected channel, and Tuoriniemi does not explicitly

teach the display of this radiotext. The “displayed information” in claim 9 relates to *at least one channel that is not the selected channel*, as expressly recited in claim 1. The existence of radiotext information for the currently-selected channel in Tuoriniemi does not teach or suggest the display of radiotext information for non-selected channels. For this reason, claim 9 is allowable over the cited art. In addition, claim 9 depends on claim 1, which is allowable for the reasons given above. As a result, claim 9 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner’s rejection of claim 9 under 35 U.S.C. §103(a) be reversed.

Claim 19

Claim 19 is grouped with claim 9, and stands or falls according to the allowability of claim 9.

Issue 2: Whether claim 2 is unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob and Shigematsu

Claim 2 is grouped with claim 1, and stands or falls according to the allowability of claim 1.

Issue 3: Whether claims 3-4 and 13-14 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob, Shigematsu, Yuen, and Liebenow

Claim 3

The arguments above with respect to claim 1 apply equally to claim 3, and are incorporated in this section by reference. In the rejection, the Examiner states that Liebenow teaches a radio or television receiver where a user may specify a list of favorite

channels or stations, and concludes that it would have been obvious based on the teachings of Liebenow to modify Tuoriniemi “such that the memory contains a favorites list, to provide means for the user to simultaneously listen to a radio program/song and view other program/songs available which may be among their favorites list.” Again, the Examiner’s rationale for combining Liebenow with Tuoriniemi is essentially so one would enjoy the benefits of the claimed invention. Neither Liebenow, Tuoriniemi, nor knowledge in the art teach or suggest the desirability of this combination absent the benefits outlined in the claims, which amounts to impermissible hindsight reconstruction. For this reason, the combination of Liebenow with Tuoriniemi and the other cited art is improper. In addition, claim 3 depends on claim 2, which depends on claim 1, which is allowable for the reasons given above. As a result, claim 3 is also allowable as depending on an allowable independent claim. For the many reasons given above, appellant respectfully requests that the Examiner’s rejection of claim 3 under 35 U.S.C. §103(a) be reversed.

Claim 13

Claim 13 is grouped with claim 3, and stands or falls according to the allowability of claim 3.

Claim 4

The arguments above with respect to claim 1 apply equally to claim 4, and are incorporated in this section by reference. In the rejection, the Examiner states that Yuen teaches that memory contains a favorite channel list that includes a list of channel identifiers, each channel identifier corresponding to one of a subset of the set of channels received by the tuner, citing the abstract of Yuen. The abstract of Yuen cited by the Examiner contains no reference to memory for storing favorite channels, and has no reference to channel identifiers. Yuen does teach in FIGS. 15 and 39 the display of

channels according to the program that is currently playing on a channel. The filtered channel list of Yuen does not read on a list of favorite channels, as recited in claims 4 and 14. The channel guide for NBC will change from one category to another depending on the current program that is playing. For this reason, the filtered lists in Yuen do not read on the list of favorite channels recited in claims 4 and 14. Furthermore, the presets in claim 2 were supposedly disclosed in the radio of Shigematsu, while the favorite channels were supposedly disclosed in the TV listing in Yuen. How could the TV listings in Yuen be defined by a radio preset in Shigematsu? They clearly can't. While Liebenow teaches a list of favorite channels or stations, it has no teaching that the list of favorite channels or stations is at least partially defined by the at least one channel preset.

The Examiner has combined SIX references to allegedly read on the limitations in claims 4 and 14. Appellant readily admits that the sheer number of reference does not make a rejection in appropriate if there is sufficient suggestion in the references or in the art that supports the combination. However, in this case, NONE of these SIX references teach that a list of favorite channels is at least partially defined by one or more channel presets. This is a feature that is found ONLY in appellant's claims. The Examiner glosses over this fact, stating:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the list of favorite channels is at least partially defined by the at least one channel preset, to provide means for one channel preset to bring up a listing of favorites that can be associated with that preset (eg. several JAZZ stations can be viewed based upon selecting that one channel preset button).

Again, the Examiner has engaged in impermissible hindsight reconstruction by stating that one would be motivated based on the combination of these SIX references to arrive at a feature (list of favorites at least partially defined by one or more channel presets) that is only contained in the claims, and that is not present or suggested in ANY of the SIX

references. For this reason, the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 14 under 35 U.S.C. §103(a).

Appellant respectfully submits that a list of favorite channels that is at least partially defined by at least one channel preset, as recited in claims 4 and 14, patentably distinguishes over the combination of Tuoriniemi, Logan, Schwob, Shigematsu, Yuen, and Liebenow. In addition, claim 4 depends on claim 3, which depends on claim 2, which depends on claim 1, which is allowable for the reasons given above. As a result, claim 4 is allowable as depending on an allowable independent claim. For the many reasons given above, appellant respectfully requests that the Examiner's rejection of claim 4 under 35 U.S.C. §103(a) be reversed.

Claim 14

Claim 14 is grouped with claim 4, and stands or falls according to the allowability of claim 4.

Issue 4: Whether claims 5 and 15 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Logan, Schwob, Shigematsu, Yuen, and Alexander

Claim 5

The arguments above with respect to claim 1 apply equally to claim 5, and are incorporated in this section by reference. In the rejection, the Examiner states:

Alexander teaches a viewer profile which is based upon a person's viewing habits (eg. which shows they watch more frequently than others) and giving them a higher precedence over others in the viewing list

AND/OR automatically tuning the TV to that show when it is on (C30, L45-67, see Nick at Night reference).

The Examiner then concludes that it would be obvious based on these teachings in Alexander to determine a list of favorites according to channels more frequently listened to. This logic forgets one very important point. Alexander does not decide which channels to include or exclude from a list based on which channels are watched more frequently than others. The only thing Alexander does is change the *position* of the channel in the list. Thus, more frequently watched channels could be placed higher on the list, while less frequently watched channels could be placed lower on the list. Nowhere does Alexander teach or suggest including frequently watched channels in a favorite list of channels that does not include all of the channels. For this reason, Alexander does not read on the determining a list of favorites according to which channels are listened to most frequently.

Another problem with the rejection of claim 5 is the Examiner's liberal mixing of the teachings of an on-line television guide with the teachings of satellite radio. Appellant respectfully asserts for all the reasons given in the original Appeal Brief that such a liberal mixing of teachings from these two very different media types is inappropriate.

For these reasons, appellant respectfully asserts that claim 5 is allowable over the combination of Tuoriniemi, Logan, Shigematsu, Yuen, Schwob and Alexander. In addition, claim 5 depends on claim 1, which is allowable for the reasons given above. As a result, claim 5 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 5 under 35 U.S.C. §103(a) be reversed.

Claim 15

Claim 15 is grouped with claim 5, and stands or falls according to the allowability of claim 5.

Allowed Claims

The Examiner allowed claims 10-11 and 20-22, but in so doing stated that these claims were allowed "as previously indicated." Appellant points out that the Examiner has NEVER previously indicated these claims were allowable. The allowance of claims 10-11 and 20-22 in the pending office action was the first notice the Examiner has ever provided of allowable claims.

General Comments

All of the Examiner's rejections reek of hindsight reconstruction. The Federal Circuit has held:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)(quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

The Federal Circuit also held:

Care must be taken to avoid hindsight reconstruction by using "the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988)(quoting Orthopedic

Equip. Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983)).

A detailed look at the rejections shows many features and combinations of features that are only disclosed in the claims, yet the Examiner has used the patent claims as a guide through the maze of prior art references, combining the references in a particular way so as to allegedly achieve the result of the claims. This amounts to impermissible hindsight reconstruction. This conclusion is bolstered by the fact that the Examiner has relied upon SIX different references in an attempt to show a combination for all of the limitation in appellant's claims. Appellant readily acknowledges that the sheer number of references does not make the rejection inappropriate if there is sufficient motivation in the art or in the references themselves to support the combination. However, in this case, the only motivation the Examiner has suggested for combining these references is the advantages that are only taught in the claims. In the two different Requests for Reconsideration filed on 04/16/03 and on 08/08/03, appellant challenged the Examiner to provide rationale for combining the references that is based on teachings of the references or knowledge in the art, not based on the desirability of the claimed invention. Yet the Examiner has not met appellant's challenge. Not even in the new, pending office action has the Examiner met this challenge. Nowhere do ANY of the references nor ANY knowledge in the art teach or suggest the desirability of displaying information relating to a non-selected satellite radio channel on the display of the satellite radio receiver. We can draw a reasonable inference from the fact that the Examiner has not produced rationale for combining the references based on the references themselves or based on knowledge in the art that the combination is improper, because the only motivation cited by the Examiner is cited in appellant's claims. For this reason, the pending claims are clearly allowable over the cited art.

CONCLUSION

Claims 1-9 and 12-19 are addressed in this Appeal. For the numerous reasons articulated above, appellant maintains that the rejection of claims 1-9 and 12-19 under 35 U.S.C. § 103(a) is erroneous.

Appellant respectfully submits that this Supplemental Appeal Brief fully responds to, and successfully contravenes, every ground of rejection and respectfully requests that the final rejection be reversed and that all claims in the subject patent application be found allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Derek P. Martin", written over a horizontal line.

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APPENDIX - REJECTED CLAIMS

- 1 1. (Original) A satellite radio receiver comprising:
2 a satellite radio processor that receives a plurality of digital satellite radio signals
3 on a plurality of channels, each digital satellite radio signal including a radio program and
4 identifying information related to the radio program, the satellite radio processor
5 outputting audio information corresponding to the radio program in one of the digital
6 satellite radio signals that correspond to a selected channel; and
7 a display within the satellite radio receiver that is coupled to the satellite radio
8 processor and that displays information regarding at least one channel that is not the
9 selected channel, wherein the displayed information is derived from the identifying
10 information for the at least one channel that is not the selected channel.
- 1 2. (Original) The satellite radio receiver of claim 1 further comprising a memory coupled
2 to the satellite radio processor, the memory containing at least one channel preset.
- 1 3. (Original) The satellite radio receiver of claim 2 wherein the memory further contains
2 a list of favorite channels, wherein the at least one channel that is not the selected channel
3 is in the list of favorite channels.
- 1 4. (Original) The satellite radio receiver of claim 3 wherein the list of favorite channels is
2 at least partially defined by the at least one channel preset.
- 1 5. (Original) The satellite radio receiver of claim 3 wherein the list of favorite channels is
2 determined by the satellite radio processor according to which channels are listened to
3 most frequently.

1 6. (Original) The satellite radio receiver of claim 1 wherein the display further displays
2 information regarding the selected channel, wherein the displayed information regarding
3 the selected channel is derived from the identifying information for the selected channel.

1 7. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes a title for the radio program.

1 8. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes time remaining for the radio program.

1 9. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes artist and song title for the radio program when the radio program comprises a
3 musical radio program.

1 12. (Original) A method for displaying radio program information to a user on a display
2 within a satellite radio receiver, the method comprising the steps of:
3 receiving a plurality of digital satellite radio signals on a plurality of channels,
4 each digital satellite radio signal including a radio program and identifying information
5 related to the radio program;
6 outputting audio information corresponding to the radio program in one of the
7 digital satellite radio signals that correspond to a selected channel; and
8 displaying information regarding at least one channel that is not the selected
9 channel on the display, wherein the displayed information is derived from the identifying
10 information for the at least one channel that is not the selected channel.

1 13. (Original) The method of claim 12 further comprising the step of storing a list of
2 favorite channels, wherein the at least one channel that is not the selected channel is in
3 the list of favorite channels.

1 14. (Original) The method of claim 13 wherein the list of favorite channels is at least
2 partially defined by at least one channel preset.

1 15. (Original) The method of claim 13 further comprising the step of determining the list
2 of favorite channels according to which channels are listened to most frequently.

1 16. (Original) The method of claim 12 further comprising the step of displaying
2 information regarding the selected channel, wherein the displayed information regarding
3 the selected channel is derived from the identifying information for the selected channel.

1 17. (Original) The method of claim 12 wherein the displayed information includes a title
2 for the radio program.

1 18. (Original) The method of claim 12 wherein the displayed information includes time
2 remaining for the radio program.

1 19. (Original) The method of claim 12 wherein the displayed information includes artist
2 and song title for the radio program when the radio program comprises a musical radio
3 program.